REMARKS

Reconsideration of the application in light of the amendments and the following

remarks is respectfully requested.

Applicants acknowledge the courtesy and effort extended by the Examiner to

their attorney, Richard J. Katz, during a telephone interview. The substance of the interview

addressed claims 1-4 and proposed amendments to overcome their rejection under 35 U.S.C. §

112.

**Status of the Claims** 

Claims 1-16 are pending. Claims 1-8, 13, 15, 17 and 18 have been amended. No

new matter has been added.

Applicants appreciatively acknowledge the Examiner's indication of allowable

subject matter in claims 1-4. Claims 1-4 have been amended, and Applicants submit that for the

reasons discussed below claims 1-4 are now in condition for allowance.

Rejection Under 35 U.S.C. § 112

Claims 1-18 stand rejected under 35 U.S.C. § 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter of the

invention. Claims 1-8, 13, 15, 17 and 18 have been amended, and Applicants submit that

amended claims 1-18 are in conformance with the requirements of 35 U.S.C. § 112. Therefore,

Applicants request withdrawal and reconsideration of the rejection.

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Rejection Under 35 U.S.C. § 101

Claims 5-7 stand rejected under 35 U.S.C. § 101 as being unpatentable for

claiming non-statutory subject matter. The Examiner contends that claim 5 recites a recording

medium which is a storage medium and, thus, cannot contain means.

Amended claim 5 is directed to a recording medium, and now recites features of

"a data structure stored thereon." Applicant submits that amended claim 5 now recites statutory

subject matter. Amended claims 6 and 7 depend from claim 5, and also recite statutory subject

matter. Withdrawal and reconsideration of the rejection is requested.

Rejection under 35 U.S.C. § 103

Claims 5, 7-8, 10-13 and 15-18 stand rejected under 35 U.S.C. § 103(a0 as being

unpatentable over U.S. Patent No. 6, 404,781 to Kawamae et al. ("Kawamae") in view of U.S.

Patent No. 6,731,774 to Hosaka et al. ("Hosaka"). The feature of "said packing data is

subdivided into data each having a fixed length" recited in claims 5, 8 and 13 was not examined.

The Examiner contends that Kawamae discloses most of the features of claims 5.

8 and 13. However, the Examiner acknowledges that Kawamae does not disclose that the

embedding data is repeatedly connected sequentially without interval. The Examiner cites

Hosaka as disclosing that a watermark is repeated vertically and horizontally and contends this is

sequentially connected without interval. The Examiner states that it would have been obvious

for a person of ordinary skill in the art at the time of the invention to combine Kawamae and

Hosaka to achieve the invention of claims 5, 8 and 13.

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Hosaka discloses that an "address setting portion 1032 supplies, to the memory

1031, addresses to specify not only one memory position corresponding to the input coordinate

(x, y) but also positions separate from the memory position in the vertical direction and the

horizontal direction by a distance an integral number of times, like once twice, three times, ...,

as large as L." (Emphasis Added.) (Hosaka, column 5, lines 19-26.)

Amended independent claim 5 recites "repeatedly connecting said embedding

data at least three times sequentially without interval." Amended claims 8 and 13 recite that the

"embedding data is repeatedly connected at least three times sequentially without interval." In

contrast to disclosing repeating the embedding data " at least three times sequentially without

interval," Hosaka discloses embedding the data at intervals that are separate "in the vertical

direction and the horizontal direction by a distance." Therefore, the combination of Kawamae

and Hosaka neither discloses nor suggests, singly or in combination, the invention of amended

claims 5, 8 and 13. Thus, the required prima facie case of obviousness over amended claims 5, 8

and 13 has not been established.

Claim 7 depends from claim 5. Claims 10-12 depend from claim 8. Claims 15-

18 depend from claim 13. Claims 7, 10-12 and 15-18 are patentable over the combination of

Kawamae and Hosaka for at least the same reasons as their respective base claim. Thus, the

required prima facie case of obviousness over amended claims 7, 10-12 and 15-18 has not been

established. Withdrawal and reconsideration of the rejection is requested.

Claims 6, 9 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable

over Kawamae and Hosaka in view of U.S. patent No. 6,725,372 to Lewis et al. ("Lewis"). The

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Examiner contends that the combination of Kawamae and Hosaka discloses or suggests most of

the features of claims 6, 9 and 14. However, the Examiner acknowledges that Kawamae and

Hosaka does not disclose or suggest encrypting the embedding data. The Examiner cites Lewis

as disclosing that watermark bits can be encrypted. The Examiner states that it would have been

obvious for a person of ordinary skill in the art at the time of the invention to combine Kawamae,

Hosaka and Lewis to achieve the invention of claims 6, 9, and 14.

Claim 6 depends from claim 5. Claim 9 depends from claim 8. Claim 14

depends from claim 13. Claims 6, 9 and 14 recite their own features along with the features of

their base claim and any intervening claims. Lewis does not disclose the feature of repeating the

embedding data "at least three times sequentially without interval" as recited in the respective

base claims for claims 6, 9 and 14. As discussed above, this feature is not disclosed nor

suggested by the combination of Kawamae and Hosaka. Therefore, the combination of

Kawamae, Hosaka and Lewis does not disclose nor suggest, singly or in combination, the

invention of claims 6, 9, and 14. Thus, the required prima facie case of obviousness over claims

6, 9 and 14 has not been established. Withdrawal and reconsideration of the rejection is

requested.

**CONCLUSION** 

Each and every point raised in the Office Action dated July 15, 2004 has been

addressed on the basis of the above amendments and remarks. In view of the foregoing it is

believed that claims 1-18 are in condition for allowance and it is respectfully requested that the

application be reconsidered and that all pending claims be allowed and the case passed to issue.

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If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

Dated: October 14, 2004

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